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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,404	07/18/2006	Jin Li	USP3292C/SZ118-SZZ	2574
30265 7590 12/23/2009 DAVID AND RAYMOND PATENT FIRM 108 N. YNEZ AVE., SUITE 128 MONTEREY PARK, CA 91754			EXAMINER SANTIAGO, MARICELI	
			ART UNIT 2879	PAPER NUMBER
			MAIL DATE 12/23/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/586,404	LI, JIN	
	Examiner	Art Unit	
	Mariceli Santiago	2879	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 May 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 23, 2009 has been entered.

Response to Amendment

Receipt of the Amendment, filed on November 23, 2009, is acknowledged.

Cancellation of claims 1-18 has been entered.

Claims 19-25 are pending in the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (JP 2003-109547 A) in view of Kling (US 6,175,197), and further in view of Borowiec (EP 646941 A1).

Regarding claim 19, Yamamoto discloses a magnetic light, comprising: an air-filled light body (1) having an inner cavity, at least a through slot (5a) defined on said inner cavity, and a fluorescent layer coated onto said inner cavity (¶[0019]), and a magnetic body (2a) positioned in

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said through slot of said inner cavity, and is arranged to generate high frequency resonance with said fluorescent layer so as to allow said fluorescent layer to generate illumination.

The recitation “so as to allow said fluorescent layer to generate illumination having an enhanced luminous efficiency, extended life span and enhanced energy saving ability” is considered a functional limitation, i.e., applicant is claiming the invention based on what it does rather than by what it is. It is elementary that mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. *In re Swinehart*, 169 USPQ 226 (CCPA 1971).

Yamamoto fails to exemplify the limitation of a glass tube communicated with said inner cavity for storing a predetermined amount of mercury. Kling discloses a magnetic light which is further provided with a glass tube (72) in communication with an inner cavity of an air-filled light body (12), the glass tube (72) is provided with an amalgam (104) in order to control the mercury vapor pressure during operation of the lamp. Thus, it would have been obvious at the time the invention was made to a person having ordinary skills in the art to incorporate the glass tube and amalgam assembly as disclosed by Kling in order to control the mercury vapor pressure during operation of the lamp.

Yamamoto in view of Kling fails to exemplify the limitation of a glass tube extended into said inner cavity and communicated with said inner cavity for storing a predetermined amount of mercury. Borowiec discloses a magnetic light (Fig. 3) which is further provided with a glass tube (52) extending into and in communication with an inner cavity of an air-filled light body (12), the

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glass tube (52) is provided with an amalgam (34) in order to control the mercury vapor pressure during operation of the lamp, furthermore, the glass tube is extended into said inner cavity in order to control position of the amalgam within the inner cavity thus providing better operating temperature control of the amalgam. Thus, it would have been obvious at the time the invention was made to a person having ordinary skills in the art to incorporate the glass tube and amalgam assembly as disclosed by Boroweic in order to control the mercury vapor pressure during operation of the lamp and position of the amalgam within the inner cavity.

Regarding claim 20, Kling discloses a magnetic light wherein said light body has a through slot disposed at one end of said light body (Fig. 1).

Regarding claim 21, Yamamoto discloses a magnetic light wherein said light body has a pair of through slots respectively disposed at opposite ends of said light body (Fig. 3).

Regarding claims 22 and 23, Kling discloses a magnetic light wherein said light body is selected from a group consisting of round shape body, oblate shape body, rectangle shape body, cylinder shape body, elliptical shape body, flat panel body, ring shape body and tubular shape body (Fig. 1).

Regarding claims 24 and 25, Kling discloses a magnetic light wherein said through slot is selected from a group consisting of light body is selected from a group consisting of round shape slot, oblate shape slot, rectangle shape slot, and polygonal shape slot (Fig. 1).

Response to Arguments

Applicant's arguments filed November 23, 2009 have been fully considered but they are not persuasive.

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Rejection of claim 19¹ under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (JP 2003-109547 A) in view of Kling (US 6,175,197), and further in view of Borowiec (EP 646941 A1).

Applicant contends that neither Yamamoto or Kling discloses the mechanism of operation and functional limitations of the magnetic lamp as claimed, i.e., "arranged to generate high frequency resonance toward said fluorescent layer, wherein said fluorescent layer, after said high frequency resonance, is then arranged to generate illumination having an enhanced luminous efficiency, extended life span and enhanced energy saving ability" and that the examiner is using the hindsight analysis syndrome to meet the functional recitation required by the claim language. Applicant arguments are not found persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Moreover, Yamamoto discloses a magnetic or electrodeless light comprising: an air-filled light body (1) having an inner cavity, at least a through slot (5a) defined on said inner cavity, and a fluorescent layer coated onto said inner cavity (¶[0019]), and a magnetic body (2a) positioned in said through slot of said inner cavity, and is arranged to generate high frequency resonance with said fluorescent layer. The disclosed electrodeless lamp uses a magnetic body (2a) to generate a high frequency wavelength, i.e., a high frequency resonance, that excites the gas

¹ Combined subject matter of cancelled claims 10-12.

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sealed within the inner cavity generating UV light which activates the fluorescent material to generate visible light. Thus, the disclosed magnetic body (2a) is arranged to generate high frequency resonance toward said fluorescent layer, wherein said fluorescent layer, after said high frequency resonance, is then arranged to generate illumination.

The recitation “so as to allow said fluorescent layer to generate illumination having an enhanced luminous efficiency, extended life span and enhanced energy saving ability” is considered a functional limitation, i.e., applicant is claiming the invention based on what it does rather than by what it is. It is elementary that mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. *In re Swinehart*, 169 USPQ 226 (CCPA 1971).

Conclusion

The rejections above rely on the references for all the teachings expressed in the text of the references and/or one of ordinary skill in the art would have reasonably understood or implied from the texts of the references. To emphasize certain aspects of the prior art, only specific portions of the texts have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combinations of the cited references may be relied on in future rejections in view of amendments.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mariceli Santiago whose telephone number is (571) 272-2464. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel, can be reached on (571) 272-2457. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mariceli Santiago/

Primary Examiner, Art Unit 2879